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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,656	03/03/2005	Luigi Resconi	FE 6048 (US)	5823

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EXAMINER	
LEE, RIP A	

ART UNIT	PAPER NUMBER
1796	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/526,656	RESCONI ET AL.	
	Examiner	Art Unit	
	RIP A. LEE	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 June 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5 and 8-11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5 and 8-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *06-06-008*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This office action follows a response filed on June 6, 2008. Claims 1, 3, and 5 were amended to correct matters of form. Claims 1-3, 5, and 8-11 are pending.

Claim Objections

1. Claim 1 is objected to because of the following informalities: In line 4, please insert "said" prior to "at least one alpha olefin" to indicate that it is the alpha olefin of formula CH_2=CHZ, instead of an alpha olefin such as propylene, that is being contacted with the catalyst. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3, 5, and 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is drawn to a process for making polymer in presence of a catalyst derived from a metallocene of formula (IV) or (V). In the formula, ancillary ligand X, which is necessarily monovalent, has been defined as OR'O, which is a divalent substituent.

Claim 3 also recites metallocenes (IV) and (V) in which ligand X is a divalent OR'O group.

Due to this inconsistency, claims are rendered indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Dependent claims 2, 5, and 8-11 are subsumed under the rejection.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-3, 5, and 8-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 18-21 of copending Application No. 10/571,404. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a process of preparing a polymer of ethylene and C_{4+} alpha olefin in the presence of substantially the same catalyst. Note especially in claim 18 of the copending application where $R^1 \neq H$ and claim 23 where R^7 is $C(R^{14})_3$.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-3, 5, and 8-11 are directed to an invention not patentably distinct from claims of commonly assigned 10/571,404 for the same reasons set forth above. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and

an application of common ownership (see MPEP Chapter 2300). Commonly assigned 10/571,404, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned *at the time the invention in this application was made*, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

6. Claims 1-3, 5, and 8-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 21-27, 29, 32, 33, 37, 38, and 40 of copending Application No. 10/571,389. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a process of preparing a polymer of ethylene and C_{4+} alpha olefin in the presence of substantially the same catalyst. Note especially in claim 21 of the copending application where $R^1 \neq H$, claim 25 where $R^{4'}$, $R^{5'}$, or $R^{6'} \neq H$, and the combination of claims 25 and 26 where $R^{5'} \neq H$ and $R^{3'}$, $R^{4'}$, $R^{6'}$, $R^{7'}$ are hydrogen.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-3, 5, and 8-11 are directed to an invention not patentably distinct from claims of commonly assigned 10/571,389 for the same reasons set forth above. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 10/571,389, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or

(g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned *at the time the invention in this application was made*, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

7. Claims 1-3, 5, and 8-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 23-27, 29, 30, 31, 33, 36, 37, 41, 42, and 44 of copending Application No. 10/571,403. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a process of preparing a polymer of ethylene and C_{4+} alpha olefin in the presence of substantially the same catalyst. Note especially in claim 23 of the copending application where $R^1 \neq H$ and claim 30 where $R^{5'}$ is $C(R^{12})_3$.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-3, 5, and 8-11 are directed to an invention not patentably distinct from claims of commonly assigned 10/571,403 for the same reasons set forth above. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 10/571,403, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly

owned *at the time the invention in this application was made*, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

8. Claims 1-3, 5, and 8-11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 20-22, 24-28, 30, 32, 35, 36, and 38 of copending Application No. 10/571,382. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to a process of preparing a polymer of ethylene and C_{4+} alpha olefin in the presence of substantially the same catalyst. Note especially in claim 24 of the copending application where T = (IIb) and claim 27 where R^{12}, R^{13}, or R^{14} are alkyl, cylcoalkyl, aryl, alkylaryl, or arylalkyl.

While claims of the present invention do not recite a multi-stage process, claims drawn to a process "comprising" particular steps do not exclude any unrecited steps. Therefore, it is deemed that the claims of the instant application are generic to, *i.e.*, fully encompass, the claims of the copending application, and therefore, the claims of the instant application are anticipated by the claims of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-3, 5, and 8-11 are directed to an invention not patentably distinct from claims of commonly assigned 10/571,382 for the same reasons set forth above. The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 10/571,382, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35

U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned *at the time the invention in this application was made*, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Terminal Disclaimer

9. Terminal disclaimers disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of applications 10/571,403, 10/571,404, 10/571,389, 10/571,382 and were filed on June 6, 2008. Terminal disclaimers will not be approved since the incorrect forms (PTO/SB/26) were submitted. Applicant is requested to refile terminal disclaimers using PTO/SB/25.

Response to Arguments

10. Provisional obviousness-type double patenting rejections have been maintained. Rejections will be withdrawn when Applicant files appropriate terminal disclaimers. Applicant is reminded to submit showing that conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

Claims remain patentably distinct over the closest prior art, Ewen *et al.* (U.S. 6,444,833) and Ewen *et al.* (6,635,779), which disclose the compounds Me_2Si(2,5-Me_2-3-Ph-cyclopentadienyl-thiophene)$_2ZrCl_2$, Me_2Si(2,5-Me_2-3-(2′-MePh)cyclopentadienyl-thiophene)$_2$ $ZrCl_2$, and Me_2Si(2,5-Me_2-3-(2′,4′,6′-MePh)cyclopentadienyl-thiophene)$_2ZrCl_2$ having utility as a polymerization catalyst component. The compounds possess the requisite substituent in the 5-position of the cyclopentadienyl-thiophene ring, but they lack the appropriate substitution pattern in the 3-phenyl substituent.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rip A. Lee whose telephone number is (571)272-1104. The examiner can be reached on Monday through Friday from 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu S. Jagannathan, can be reached at (571)272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

/Rip A. Lee/
Art Unit 1796

September 25, 2008